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CHARLES ELMORE CROPL

IN THE

Supreme Court of the United States

OCTOBER TERM 1950

No. 396.

SUTHERLAND PAPER COMPANY,

Petitioner,

v.

GRANT PAPER BOX CO. AND CARL G. DREYMANN,

Respondents.

PETITION FOR WRIT OF CERTIORARI AND BRIEF IN SUPPORT THEREOF

RAYMOND F. ADAMS,
MAHLON E. LEWIS,
CURT VON BOETTICHER, JR.,
Counsel for Petitioner.

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SUTHERLAND PAPER COMPANY,

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GRANT PAPER BOX CO. AND CARL G. DREYMANN,

Respondents.

PETITION FOR WRIT OF CERTIORARI

TO THE HONORABLE, THE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioner, Sutherland Paper Company, prays that a writ of certiorari issue to the United States Court of Appeals for the Third Circuit to review the judgment of that court filed August 7, 1950 (R. 1090, 1091).

A certified transcript of the record in this case, including the proceedings in the Court of Appeals, is furnished herewith in compliance with Rule 38 of the rules of this Court.

Summary Statement of the Matter Involved

This is a patent suit (declaratory judgment-counterclaim for infringement) brought by petitioner in the United States District Court for the Western District of Pennsyl-

vania. The District Court held the patent valid but not infringed (R. 100a). The opinion of the District Court is reported in 82 F. Supp. 250.

On cross appeals, the Court of Appeals dismissed petitioner's appeal and reversed and remanded the cause for further proceedings on respondents' appeal (R. 1090). The opinion of the Court of Appeals is reported in 183 F. 2d 926.

The issue upon which review by this Court is sought is presented by the finding by the Court of Appeals that the District Court's denial of respondents' motion for a continuance, made two weeks before trial, was an abuse of discretion (Court of Appeals Opinion, R. 1074 to 1090). The effect of this finding will be to disturb practice in the District Courts, to make the practice in the District Courts of the Third Circuit different from that in other Circuits and to impose an unwarranted burden upon litigants in contravention of the policy of this Court.

The patent in controversy relates to a composition, for coating and laminating paper products (R. 637a), composed substantially of (1) amorphous petroleum wax of an apparent melting point of 120°-170°F. (2) carrying a suspended colloid. One question of infringement is whether the patent requires the suspended colloid to be an added colloid or whether a resinous impurity in the wax is sufficient.

The Court of Appeals for the First Circuit in another litigation* gave the patent a broad construction on the facts there before it. The District Court in the present case declined to follow the decision of the First Circuit for the reasons stated in its opinion (R. 92a-100a) and entered a decree that Patent No. 2,031,036 is valid to the extent

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* *Grant Paper Box Co.* v. *Russell Box Co.*, 154 F. 2d 729 (1946), Cert. Denied 329 U. S. 741 (1946).

that it claims an adhesive composition with a suspended colloid added which is not part of the petroleum compound (R. 101a). On appeal, the Court of Appeals for the Third Circuit (Circuit Judge Hastie) held that the patent is not limited to added colloids but includes adhesive compositions containing resinous impurities not foreign to petroleum (R. 1077-1078).

The record below is barren of any proof that the petitioner's waxes contain resinous impurities foreign to petroleum. The evidence as to whether they contain resinous impurities native to petroleum is in conflict. During the trial respondents presented evidence to show that the waxes contained some resinous impurities (R. 366a-377a) but the District Court chose to accept petitioner's proof to the contrary, and the Court of Appeals agreed, stating (R. 1079):

> "The District Court found that the 'uncompounded petroleum wax used by plaintiff contains more than 90 per cent microcrystalline wax, the balance being oil.' It concluded, of course, that there was no infringement. If that finding stands, even on the construction we have now given the patent, the plaintiff is entitled to prevail."

After the decision of the District Court, respondents asserted that they had been afforded insufficient time to analyze petitioner's wax compounds adequately or to prepare their case by reason of the District Court's refusal to grant respondents' motion for a continuance made somewhat less than two weeks before trial.

The motion for a continuance was heard on September 28, 1948. It was grounded on the assertion that Dreymann, one of the respondents and the patentee of the invention in suit, had been ill and unable to carry on experimental work and that the District Court's decision on respondents' motion for discovery left respondents'

counsel insufficient time to prepare for trial and to conduct tests upon petitioner's waxes (R. 69a). This motion was fully argued. At the time of the argument the District Court (Judge Gibson) stated that he would consult with the other members of the court before deciding the motion (R. 1067):

> "The Court: I don't like to do it. I will take the matter under consideration, but I will rule on it today. I want to consult with my colleagues in the matter, who are somewhat interested in the work of the court, but I think your motion will have to be denied."

The motion was denied on September 28, 1948. The motion for continuance was renewed at the beginning of the trial on October 4, 1948, and again denied (R. 130a). No motion was made at the end of the trial for leave to adduce additional evidence.

After the entry of the decree in the District Court, respondents moved for a new trial, asserting that Judge Gibson's refusal to grant discovery with respect to the tests petitioner would rely upon to show noninfringement and the trial court's refusal to grant a continuance to permit respondents to make tests upon petitioner's waxes was prejudicial and constituted abuse of discretion (R. 101-126). Judge McVicar in denying the motion did so *inter alia* "for the further reason that no error is found in the rulings made by Judge Gibson or any abuse of discretion" (R. 129a).

On appeal, the denial of the motion for a continuance and for a new trial was asserted as an abuse of discretion. The Court of Appeals agreed and remanded the case to the District Court for a new trial. In doing so, the Court of Appeals stated: "It is true that some delay in the early stages of this litigation may be attributable to the defendants. But we do not regard the lower court's denial of a continuance, in the posture of this case on September 23, 1948, as an appropriate reprimand" (R. 1081).

The complaint for declaratory judgment was filed on October 21, 1946 and issue was joined December 31, 1946.

On April 23, 1947, respondents moved for a separate trial of certain of the issues, for judgment on the pleadings and for a dismissal of the complaint as to Dreymann, which motions were denied on June 24, 1947. In July, 1947, depositions were taken by both parties. Six months later, on February 6, 1948, respondents moved for summary judgment* but without noticing the motion for hearing. Early in April petitioner secured a trial setting of this cause for October 4, 1948, and on April 7, 1948, notified respondents of the trial date.

On May 1, 1948, respondents served interrogatories and a motion for discovery upon petitioner returnable on May 24, 1948, and at the same time respondents filed a notice of argument with respect to the motion for summary judgment theretofore filed on February 6, 1948. Argument was set for August 10, 1948.

On May 27, 1948, petitioner answered twenty-six of respondents' interrogatories and objected to eight (R. 68a). Concurrently, petitioner voluntarily offered to give respondents discovery as to the first three items of the motion for discovery, namely, samples of the laminating mixtures commercially used by the petitioner, access to petitioner's plant for inspection and permission to make copies of all orders, documents and reports identifying the laminating mixtures (R. 65a). Believing that the remainder of the discovery sought was improper, petitioner conditioned its offer on a withdrawal of the balance of the motion. Respondents rejected the offer.

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* This motion was directed to the defense of unclean hands pleaded in petitioner's answer to the counterclaim and based upon an asserted existing license agreement between the parties. It had no relationship to the merits of the patent controversy and was denied by the District Court on the ground that the issue presented was identical with the matter theretofore presented on the motion for judgment on the pleadings and denied June 24, 1947 (R. 67a).

On August tenth the several motions then pending, including the motions relating to discovery, were argued before the District Court. Pending a decision on the motions, respondents took the deposition of petitioner's Vice-President and Technical Director, Sherwood, starting August 25, 1948, and during the course of the deposition respondents asked for and were furnished with specimens of laminated sheet material taken from petitioner's machinery and specimens of waxes taken from petitioner's tanks (R. 393a). Thus, respondents had *inter partes* samples of waxes and products for six weeks prior to trial. Testimony as to results of detailed tests of such samples were offered by respondents at the trial (R. 366a-371a, 373a-377a).

On September 23, 1948, the District Court allowed the motion for discovery as to the three items which petitioner had previously agreed to give and denied the motion for further discovery (R. 65a, 68a). On September 28, 1948, respondents' motion for continuance was denied but on the following day, September 29, 1948, respondents requested and were furnished with additional samples of petitioner's wax compositions (R. 394a).

Admittedly, tests on the wax compositions in issue can be run in twenty to forty hours (R. 70a), so that the only thing denied to respondents by the District Court's action in denying discovery was information as to the tests petitioner would rely upon in defense to the claim of infringement. Significantly, as pointed out by the Court of Appeals, the denial of the motion for discovery has not been relied upon as error (R. 1080).

The Court of Appeals concluded that "Defendants, reasonably, even necessarily, postponed important and time consuming portions of their trial preparation until after the decision on these motions" (R. 1080). This holding of the Court of Appeals penalizes petitioner's diligence and imposes upon petitioner the burden and expense

of a new trial as the price of excusing respondents' laches. Judge Gibson, familiar with the litigation, ruled against respondents, presumably with the concurrence of the other judges of the court with whom Judge Gibson consulted (R. 1067), as did Judge McVicar on the motion for a new trial (R. 129a).

Jurisdiction

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code, as amended (28 U. S. C., Sec. 1254).

The judgment of the Court of Appeals for the Third Circuit was entered on August 7, 1950 (R. 1091).

Questions Presented

1. Was the act of the Court of Appeals, in reversing the District Court's denial of a continuance to a litigant who deliberately postponed trial preparation pending disposition of interlocutory matters, a substitution of its discretion for the discretion of the District Court, and hence improper, or was it a valid exercise of its appellate jurisdiction, and hence proper?

2. Did the District Court's denial of the motion for a continuance, in view of respondents' dilatory tactics, amount to an abuse of discretion such as to justify interference by the Court of Appeals with the District Court's effort to secure to petitioner a "just, speedy and inexpensive determination" of its action?

3. Can there be an abuse of discretion with respect to the conduct of a trial where the exercise of the discretion involves the balance of prejudice to one litigant against prejudice to the other?

Reasons for Granting the Writ

1. The holding of the Court of Appeals is contrary to the decision of this Court in *Valdes* v. *Central Altagracia*, 223 U. S. 58, 73 (1911) which holds that the discretion of the District Court in overruling an application for continuance is not subject to review "except in case of such clear error as to amount to a plain abuse springing from an arbitrary exercise of power."

2. The holding of the Court of Appeals is in conflict with the decisions of Courts of Appeals of other circuits, for example, the Court of Appeals for the Second Circuit in *Dietrich* v. *United States Shipping Board*, 9 F. 2d 733 (1925); the Fourth Circuit in *Virginia Beach Bus Line* v. *Campbell*, 73 F. 2d 97 (1934); the Sixth Circuit in *Smith* v. *Daniel*, 46 F. 2d 740 (1931) and the Ninth Circuit in *Pacey* v. *McKinney*, 125 Fed. 675 (1903).

3. The holding of the Court of Appeals is in conflict with the policy of this Court as announced in Rule 1 of the Rules of Civil Procedure in that it will operate to deprive the District Courts of the Third Circuit of discretion in the control of their calendars in cases of applications for continuance based upon insufficient trial preparation resulting from lack of diligence.

WHEREFORE, THIS PETITIONER, respectfully prays that a Writ of Certiorari be issued to the United States Court of Appeals for the Third Circuit to the end that its finding on the issue of abuse of discretion be reviewed and determined by this Court, its judgment be reversed, and petitioner be granted such other and further relief as may be proper.

SUTHERLAND PAPER COMPANY

By

RAYMOND F. ADAMS,
MAHLON E. LEWIS,
CURT VON BOETTICHER, JR.,
Counsel for Petitioner.

New York, N. Y.,
November 1, 1950.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinions of the Courts Below

The opinion of the Court of Appeals for the Third Circuit (Circuit Judges Maris, Goodrich and Hastie, opinion by Judge Hastie) appears at page 1074 of the record and is reported in 183 F. 2d 926. The opinion of the District Court for the Western District of Pennsylvania (Judge Gibson) appears at page 92a of the record and is reported in 82 F. Supp. 250.

Jurisdiction

The jurisdictional statement appears in the accompanying petition.

Statement of the Case

The essential facts of the case are stated in the accompanying petition.

Specification of Error

The Court of Appeals for the Third Circuit erred:

1. In remanding the case to the District Court for the Western District of Pennsylvania for a new trial on the ground that respondents were prejudiced by the action of the District Court in denying respondents' motion for a continuance.

2. In finding that respondents' representations made to the District Court on the motion for a continuance required that court to grant the motion, not in the exercise of its discretion, but as a matter of law.

3. In finding that respondents reasonably, even necessarily, postponed important and time consuming portions of their trial preparation until after the decision by the District Court on the motions for discovery.

4. In finding that the acts of the District Court constituted an abuse of discretion.

5. In failing to find that the District Court properly applied judicial discretion in balancing the prejudice to respondents against the prejudice to petitioner, in denying the motion for continuance.

6. In failing to apply the policy announced by this Court in Rule 1 of the Rules of Civil Procedure which requires that every action of a civil nature be determined in a just, speedy and inexpensive manner.

7. In failing to apply the rule as announced by this Court in *Valdes* v. *Central Altagracia*, 225 U. S. 58, 73 to the effect that rulings on an application for a continuance shall not be subject to a review except in the case of plain abuse springing from an arbitrary exercise of power.

Summary of the Argument

The points of argument are the reasons relied on for allowance of the writ printed at page 8 of the petition.

ARGUMENT

1. The holding of the Court of Appeals is contrary to the decision of this Court in *Valdes* v. *Central Altagracia*, 225 U. S. 58.

The general proposition that the grant or denial of a continuance is a matter within the discretion of the trial court is accepted by the Court of Appeals. It, however, finds abuse of discretion in this case and establishes a new and narrow limit within which such discretion must be exercised by the District Court—a limit which is in conflict with the rule announced by this Court in *Valdes* v. *Central Altagracia* and which will inhibit the District Courts of the Third Circuit from directing the course of litigation before them in such a way as to insure "speedy and inexpensive" trials.

The result of the decision of the Court of Appeals, on this matter of trial procedure, is to impose a requirement upon the District Court to grant continuances, as a matter of right, in fact situations such as here presented, where the basis of the application is inadequate preparation for trial resulting from failure to prepare for trial pending decision of a motion for improper discovery.

This ruling, apart from the inevitable prejudice it imposes upon a diligent litigant, is in conflict with the ruling of this Court in the *Valdes* case *supra*, where an asserted error was the denial of a motion for continuance grounded upon the necessity for the taking of testimony of witnesses for the purpose of proving some of the allegations of the complaint. The District Court, in that case, pointed out that the matter had been pending for more than a year, that counsel had full notice of the court's intention to press the matter to issue and that the court was not disposed to delay matters. In holding that the discretion of the District Court had not been abused, this Court

stated its view that there must be an arbitrary exercise of the District Court's power before abuse can be found (p. 73):

> "Considering the assignments of error in so far as they relate alone to overruling of the application for continuance based upon the absence of witnesses, it suffices to say that the elementary rule is that the granting of a continuance of the cause was peculiarly within the sound discretion of the court below, a discretion not subject to be reviewed on appeal except in case of such clear error as to amount to a plain abuse springing from an arbitrary exercise of power. Instead of coming within this latter category, we think the facts as to the refusal to continue and the conduct of the parties make it clear that there was not only no abuse but a just exercise of discretion."

No arbitrary exercise of power appeared in the present case. The District Court was most careful to afford respondents all protection, even to the extent of consulting with his colleagues (*ante*, p. 4, R. 1067). The decision of the Court of Appeals is contrary to the ruling of this Court.

2. The holding of the Court of Appeals is in conflict with the decisions of Courts of Appeals in other circuits in analogous cases.

In circuits other than the Third, as established by decisions of several Courts of Appeals (The Second Circuit in *Dietrich* v. *United States Shipping Board*, 9 F. 2d 733; the Fourth Circuit in *Virginia Beach Bus Line* v. *Campbell*, 73 F. 2d 97; the Sixth Circuit in *Smith* v. *Daniel*, 46 F. 2d 740 and the Ninth Circuit in *Pacey* v. *McKinney*, 125 Fed. 675) in cases analogous to the case at bar, the rule is settled that the denial of an application for continuance, on the ground of inadequate preparation for trial or

inability to proceed to trial resulting from a litigant's own acts, is not an abuse of discretion.

Thus, in *Dietrich* v. *United States Shipping Board,* the Second Circuit stated the rule applicable to continuances as follows (p. 746):

> "But a party is not entitled to a continuance because he discovers he has made a mistake of law (McDonald v. Weir, 76 Mich. 243, 42 N. W. 1114), or where his application is for the mere purpose of getting better proof (Perley v. Taylor, 21 Kan. 712; * * *."

The Fourth Circuit in *Virginia Beach Bus Line* v. *Campbell* in ruling that there had been no abuse of discretion and in denying a continuance based on the absence of a witness, stated (p. 100):

> "In view of the inconvenience and expense which a continuance would have caused plaintiff, we cannot say that it was an abuse of discretion to refuse to continue for the absence of a witness of such doubtful value to defendant."

The Court of Appeals in the present case recognized that the evidence which respondents desire to adduce may not change the result (See R. 1079). Thus, prejudice to petitioner becomes a vital consideration.

The Sixth Circuit in *Smith* v. *Daniel* rejected the contention that it was an abuse of discretion to deny a continuance to permit newly employed counsel to familiarize himself with the case where there had been several preliminary adjournments in order to enable the litigant to be properly represented and she had had at least ten days' notice that the case would be set for trial. The court observed (p. 742):

> "It appears from the record that the case was definitely and peremptorily assigned for trial on February

> 8th following the continuance of January 20th. Between January 20th and January 31st the appellant was busily engaged taking depositions in various places, principally in Tennessee. At least as early as January 31st she was advised that her former counsel could not, or would not, attend the hearing set for February. When the court insisted that she do so, on February 10th, appellant was able to appear and impanel the jury. That she did not have counsel there at that time to assist her is the fault of no one but herself. The business of the courts must be disposed of, and there was no showing of inability to secure counsel."

In the present case, the delay in making tests is chargeable to no one but respondents themselves. Petitioner made a conditional offer of samples in May, 1948 (*ante*, p. 5) which was declined by respondents. Respondents were given samples in August, 1948. Respondents, however, elected to sit back and do nothing until after the District Court had confirmed petitioner's right to decline additional discovery so that respondents are themselves to blame for any resulting shortness of time in preparing their case.

The Ninth Circuit in *Pacey* v. *McKinney*, passing upon the correctness of a refusal of a continuance, sought because of the absence of witness, stated (p. 679):

> "Failing to use due diligence in obtaining information as to the names of the parties alleged in the complaint to be his agents and representatives, he was not entitled to a continuance of the case to obtain their evidence."

3. The holding of the Court of Appeals is in conflict with the policy of this Court as announced in Rule 1 of the Rules of Civil Procedure.

At the time of the adoption by this Court of the Rules of Civil Procedure for the United States District Courts, a statement of policy was announced in the first rule. This statement of policy appears in the following language: "They [the rules] shall be construed to secure the just, speedy and inexpensive determination of every action."

The limitation placed by the decision of the Court of Appeals upon the power of a District Court to regulate its calendar so as to secure a speedy and inexpensive determination of an action conflicts with this rule. If a litigant may, reasonably, even necessarily, postpone trial preparation until after the hearing and determination of motions for discovery, without limitation on whether such motions are proper or are merely frivolous, then the District Court has lost its power to comply with the directive of this Court. It must be noted that in this case the District Court denied discovery except as to items theretofore consented to by petitioner and tendered to respondents at least three months earlier and no error is assigned to this denial (R. 1080). The deposition of Sherwood could have been taken at any time. It was not dependent upon the decision of the District Court on the motions for discovery and as a matter of fact was actually taken by respondents before such decision (*ante*, pp. 5-6). The record does not support the finding of the Court of Appeals that "Defendants reasonably, even necessarily, postponed important and time consuming portions of their trial preparation until after decision on these motions" (R. 1080). On the contrary the record is replete with instances of delay on the part of respondents in carrying forward the part of the case with respect to which they had the burden of proof.

The Court of Appeals was in error in substituting its judgment for that of the District Court. The effect of such substitution is to compel petitioner to expend substantial additional sums in the retrial of an action, once fully tried, and in a situation where the proposed additional proof will not necessarily change the result. Respondents have had their day in court and should be left where the record, which they made, finds them.

Conclusion

Wherefore, petitioner prays that a Writ of Certiorari be granted, the cause be reviewed and the judgment of the Court of Appeals for the Third Circuit, on its finding of abuse of discretion, be reversed.

Respectfully submitted,

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MAHLON E. LEWIS,
CURT VON BOETTICHER, JR.,
Counsel for Petitioner.

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GRANT PAPER BOX COMPANY and CARL G. DREYMANN, Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

OPINION BELOW.

The opinion of the District Court (R. Vol. 1, pp. 77a-92a) is reported at 82 Fed. Supp. 250. The opinion of the successor judge (R. Vol. 1, p. 127a) on Motion Under Rule 59 F.R.C.P. is reported at 9 F.R.D. 422. The opinion of the Circuit Court of Appeals for the Third Circuit is reported at 183 F. (2) 926.

JURISDICTION.

The case arises under the patent laws of the United States.

QUESTION PRESENTED.

On the facts as set forth in the record, the Circuit Court of Appeals held that the District Court has abused its judicial discretion in refusing Respondent a continuance and remanded the case for further proceeding. In so doing, has the Circuit Court of Appeals acted outside its authority or in conflict with established principle?

STATEMENT.

Petitioner filed its action for Declaratory Judgment October 21, 1946, seeking to have Respondents' Letters Patent held invalid and not infringed. The action was brought after the patent had been held valid and infringed in the Circuit Court of Appeals for the First Circuit (*Grant v. Russell Box Co.*, 154 F. (2) 729, Certiorari denied, 329 U.S. 741). The Complaint was in the usual form. There was an answer and counterclaim, charging alternatively the infringement of the patent or the existence of a license. The Trial Court held the patent valid but not infringed; the Circuit Court of Appeals dismissed Petitioner's Cross Appeal on the holding of validity, and held that the Trial Court had abused its judicial discretion in refusing Respondents' motion for a continuance; and remanded the case "for further proceedings consistent with this opinion." (183 F. (2) 926).

The patent in suit was issued to one of the Respondents, Carl G. Dreymann, who made a conditional assignment to Respondent, Grant Paper Box Company. The record shows that after the filing of suit, there were numerous motions and pre-trial depositions, and then,

on May 3, 1948 Respondents filed a Motion for Summary Judgment on the license question; also interrogatories and Request for Pre-trial Discovery Under Rule 34. (See "Docket Entries," R. Vol. 1, p. 5a). These were argued August 10, 1948, and decided September 23, 1948, with the trial date set for October 4, 1948. A motion for a continuance was immediately filed, including an affidavit from Mr. Dreymann's physician showing that the party Dreymann, a gentleman in his early seventies, was too ill to proceed. (R. Vol. 1, p. 25a). The late District Judge, then getting ready to retire, and also being without a full docket, refused the continuance (R. p. 1063) because it was "embarrassing" to the Court.

Trial therefore proceeded less than two weeks after the ruling on the motions over the protest of counsel, repeated at the opening of trial (R. Vol. 1, p. 130a). Motion Under Rule 59 was made after judgment was entered. (R. Vol. 1, p. 101a). This was denied by the successor judge (R. Vol. 1, p. 127a).

Certiorari should be denied for the reasons set forth in each and all of the following points:

(1) The Petitioner's assertion that the judgment is in conflict with the decisions of this Court or of other Circuit Courts of Appeal is without merit.

(2) No question of public importance is presented by the Petition.

(3) The judgment appealed from is not a final judgment, but involved a procedural matter.

Point No. 1.

The Third Circuit Court of Appeals has not acted in conflict with the decisions of this Court or of the Circuit Courts of Appeal for the several circuits.

The Circuit Court of Appeals premised its decision with a concise statement of applicable rule of law. The Court said (183 F. (2) 926, p. 931 [R. p. 1080]):

> "There is no question that as a general proposition, the grant or denial of continuances is a matter within the discretion of the trial court. There is also no question that an abuse of that discretion is subject to correction by an appellate court. Here we find abuse of discretion. Zeal to dispose of pending litigation, commendable in itself, has resulted in deprivation of reasonable opportunity to make adequate preparation for trial. Though the court regarded the various motions which it denied on September 23 as not sound, it is clear that they were neither baseless nor frivolous. Defendants reasonably, even necessarily, postponed important and time consuming portions of their trial preparation until after decision on these motions. We cannot conceive how even the limited discovery granted defendants could have been of much use in absence of considerably more than two weeks to evaluate and interpret any data obtained and to work it into the framework of the defendants' presentation. In evaluating the court's action, we cannot ignore the fact that this was a patent infringement case which in its nature would involve technical and elaborate presentation. Moreover, the court's denial of in-

formation with respect to the technical tests to be performed by plaintiff would itself impose unanticipated burdens of preparation. To all this is added the handicap of hurried preparation during a period of ill health of Dreymann, the inventor and key technician."

The Circuit Court of Appeals, having examined the record, and having found from the facts of the case that there had been an abuse of discretion, properly acted to correct that abuse.

The opinion of the Circuit Court of Appeals is in complete harmony with the principles of law set forth in the cases relied on by Petitioner. It has, only because of the different facts in the instant case, reached a different conclusion.

In no case relied upon by Petitioner has it been denied that an Appellate Court has the right and power, and indeed the duty, to correct an abuse of the Trial Court's discretion, nor in any case has this Court overruled an Appellate Court that did so. In the case principally relied upon by Petitioner, *Valdes v. Central Altagracia,* 225 U.S. 58, an appeal was taken directly to this Court from the District Court of Puerto Rico. This Court there reviewed the proceedings in the Trial Court and concluded *on the basis of the facts* there appearing, that there had been no abuse of discretion.

On the other hand it is "elementary" that where the Trial Court has abused its discretion, it is the duty of the Court to correct such abuse. *Guardian Assurance Co. of London v. Quintana,* 227 U.S. 100, p. 103.

The conclusion reached by the Circuit Court of Appeals for the Third Circuit is entirely consistent with the general rule, and with the following cases where the facts are more nearly similar to the facts of the present case:

Royster v. Lederle (C.C.A. 6, 1942) 128 F. (2) 197;

Cornwell v. Cornwell (App. D. C. 1941) 118 F. (2) 396;

Harrah, et al. v. Morgenthau, Secretary, 89 F. (2) 863.

Neither has the Circuit Court in any way violated the letter or spirit of Rule 1 F.R.C.P. This rule not only requires that the trial be speedy and inexpensive, but that it also be *just*. In a complicated and technical case, the whole machinery of pre-trial discovery is jeopardized if the Trial Court may retain motions from May 1 to September 23, and then require trial to proceed on October 4, and the Circuit Court acted properly to preserve the rights of pre-trial procedure to the Respondent. The fact that Rule 59 has been included in the Federal Rules of Civil Procedure is a recognition of the propriety of the relief here given.

Point No. 2.

The petition presents no question or proposition of law of general significance or importance, and hence the granting of the petition cannot be urged on this ground.

In effect, the petition simply requires this Court to review the record before the Court of Appeals and then determine whether, on the facts, the Court of Appeals

was justified in finding that there had been an abuse of discretion by the Trial Court. In other words, this Court is asked to apply an accepted principle of law to a particular set of facts in a specific case and decide whether it would have reached the same conclusion as the Circuit Court.

This is not the purpose for which the Writ of Certiorari is intended.

Wisconsin Electric Co. v. Dumore Co., 282 U.S. 813;

Layne & Bowler Corp. v. Western Well Works, 261 U.S. 387;

Magnum Import Company, Inc. v. Coty, 262 U.S. 159.

In the last of these cases this Court said (p. 163):

"The jurisdiction was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing."

Point No. 3.

The judgment of the Circuit Court of Appeals is not a final judgment.

The Circuit Court remanded the case to the District Court "for further proceeding consistent with this opinion".

The opinion directs that the case should be remanded to the District Court for a new trial. The issue of infringement has not been finally adjudicated and further trial is required before a final judgment can be entered.

A judgment remanding the case "for further proceedings not inconsistent with the opinion of this Court" is not a final judgment where further trial proceedings are directed.

Gulf Refining Company of Louisiana v. U. S., **269 U.S. 125, p. 135;**

Haseltine v. Central Bank of Springfield, Mo., **183 U.S. 130, p. 131;**

Heike v. United States, **217 U.S. 423, p. 429.**

In ***American Construction Co. v. Jacksonville, Tampa & Key West Railway Co.,*** 148 U.S. 372, this Court said (p. 384):

> "Clearly, therefore, this court should not issue a writ of certiorari to review a decree of the Circuit Court of Appeals on appeal from an interlocutory order, unless it is necessary to prevent extraordinary inconvenience and embarrassment in the conduct of the cause."

In the instant case, the Petitioners were eager to press for trial when they knew of Respondents' disadvantage. They seek to justify the action by the fact that they voluntarily gave Respondents access to certain restricted information on August 25, 1948 after motions had been filed the preceding May. Petitioners cannot now complain that they have suffered a hardship.

The Circuit Court has here entered an interlocutory order to correct abuse of discretion and permit trial in accordance with the spirit of the rules. Certiorari was not intended to provide review in such cases.

In ***Hamilton Brown Shoe Co. v. Wolf Bros.,*** 240 U.S. 251, this Court said (p. 258):

> *"The decree that was sought to be reviewed by certiorari at complainant's instance was not a final one, a fact that of itself alone furnished sufficient ground for the denial of the application;* besides which it appears, by reference to our files, that the application was opposed by the present petitioner upon the ground that the case, however important to the parties, involved no question of public interest and general importance, nor any conflict between the decisions of the state and Federal Courts, or between those of Federal courts of different circuits." (Italics ours).

We submit that no reason is shown, and none exists, why a Writ of Certiorari should be granted from this judgment requiring further proceedings in a patent infringement case.

CONCLUSION.

The Petition in this case is without merit. The alleged discrepancy of decisions is purely fictitious. There is in this case only a difference of result based on a different fact basis, but the legal principle is in harmony with all of the cases on which Petitioner relies. In this case, the Third Circuit Court of Appeals found that there had been an abuse of discretion by the Trial Court.

No question of general importance is raised, and the judgment on which the Petition is founded is not a final judgment. Further proceedings are required to establish the rights of the litigants.

Wherefore Respondents pray that the Petition be denied.

Respectfully submitted,

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